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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/248,160	02/09/99	CHESTON	R RP9-98-096

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EXAMINER

TESFAMARIAM, M

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/248,160

Applicant(s)
Richard W. Cheston

Examiner
Mussle Tesfamariam

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 15, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 1, 3, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055.

As per claim 1, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in

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usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment. As per claim 3, Christer disclose in a personal computer includes a software module for converting the selected software from an unusable form into an usable form in response to the selection and the list of selected software. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 5, Christer disclose in a personal computer includes a software module for converting the selected software from a compressed form to uncompressed form. See Page 4.

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As per claim 6, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion based on the software associated with the user's function. See PP 1, 5-6.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 as applied to claim 1 above, and further in view of Houck et al, 5927050.

As per claim 2, Christer disclose in a software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which erases non-selected software from the personal computer. Houck et al disclose in a software which erases non-selected software from the personal computer. See the abstract, col 1, lines 8-14. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase unselected software. This is because it would improve Christer's system to eliminate unnecessary software from the personal computer.

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4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 as applied to claim 1 above, and further in view of Halter et al, 5319705.

As per claim 4, Christer disclose in a personal computer includes a software module for converting the selected software from the selected software. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which is converted from encrypted to unencrypted form. Halter et al disclose in a software which is converted from encrypted to unencrypted form. See the abstract, fig 12, fig 14, col 28, lines 19-26. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will be converted from encrypted to unencrypted form. This is because it would improve Christer's system to read the decoded software.

5. Claim 7, 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and www.patents.ibm.com.

As per claim 7, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal

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computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents.ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. He also fails to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 9, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. He also disclose

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in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents.ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. This is because it would improve Christer's system to differentiate how to select the necessary software from unnecessary software.

As per claim 10, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs for a personal computer includes the step of identifying the job function of the user. www.patents.ibm.com disclose in selecting the software programs for a personal computer includes the step of identifying the job function of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of

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Christer such that it will select the software programs which are needed for that personal computer in the step of identifying the job function of the user. This is because it would improve Christer's system to identify the user's job function.

As per claim 11, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion based on the software associated with the user's function. See PP 1, 5-6.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and www.patents.ibm.com as applied to claim 7 above, and further in view of Houck et al, 5927050.

As per claim 8, Christer disclose in a software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which erases non-selected software from the personal computer. Houck et al disclose in a software which erases non-selected software from the personal computer. See the abstract, col 1, lines 8-14. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase

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unselected software. This is because it would improve Christer's system to eliminate unnecessary software from the personal computer.

7. Claim 12, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com.

As per claim 12, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a module associated with the processor and responsive to the selecting of certain programs to make the selected programs active and usable. www.patents.ibm.com disclose in a module associated with the processor and responsive to the selecting of certain programs to make the selected programs active and usable. See Page 1.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select certain programs. This is because it would improve Christer's system to eliminate unnecessary programs from being selected.

As per claim 14, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later

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converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. He also disclose in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs for a personal computer includes the step of identifying the function of the user. www.patents.ibm.com disclose in selecting the software programs for a personal computer includes the step of identifying the function of the user. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer in the step of identifying the function of the user. This is because it would improve Christer's system to identify the user's job function.

As per claim 15, Christer disclose in a software module for selection of the selected software including to input the user's function and to select software for addition or deletion programs from a listing of programs which are appropriate for that user. See PP 1, 5-6.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of WWW.patents.ibm.com as applied to claim 12 above, and further in view of Houck et al, 5927050.

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As per claim 13, Christer disclose in a software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which erases from the storage device the programs not selected.

Houck et al disclose in a software which erases from the storage device the programs not selected. See the abstract, col 1, lines 8-14. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase unselected software. This is because it would improve Christer's system to eliminate unnecessary software from the personal computer.

9. Claim 16, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of Thomas, 4685055 and www.patents.ibm.com.

As per claim 16, Christer disclose in a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. He also disclose

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in storing the converted software programs in usable form into the storage of the personal computer. See fig 1, Pages 4-6. However, he fails specifically to disclose selecting the software programs which are needed for that personal computer. www.patents. ibm.com disclose selecting the software programs which are needed for that personal computer. See Page 1. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will select the software programs which are needed for that personal computer. He also fails to disclose in paying royalties on only the selected software. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 18, Christer disclose in the step of selecting the subset of programs includes a user input which serves to add to or delete from the list of programs based on user preferences. See PP 1, 5-6.

As per claim 19, Christer disclose in the step of selecting the subset of programs includes a user input which serves to add to or delete from the list of programs based on user preferences. See PP 1, 5-6. However, he fails specifically to disclose in the appropriate royalties can be paid. Official

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notice is taken that paying appropriate royalties is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include paying royalties because this would improve Christer's system to have better payment method.

As per claim 20, a personal computer system initially loaded with software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in paying royalties for a plurality of personal computers so that a single royalties can be paid for a plurality of personal computers. Thomas discloses in paying royalties on only the selected software. See column 1, lines 41-49. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will pay royalties on only the selected software. This is because it would improve Christer's system to have a secured payment.

As per claim 21, Christer disclose in preparing a list of the software for each computer along with a list of the user and the functional organization for each personal computer. See PP 1, 3-6.

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10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Christer Bernerus in view of www.patents.ibm.com as applied to claim 16 above, and further in view of Houck et al, 5927050.

As per claim 17, Christer disclose in a software including selected and non-selected software in unusable form, with the selected software later converted and loaded in usable form, with selected programs stored in the storage device in usable form after conversion from unusable form, selected programs having been selected based on the user's position and having been converted by the processor from unusable form and stored in usable form, with non-selected programs not being converted into usable form. See fig 1, Pages 4-6. However, he fails specifically to disclose in a software which erases non-selected software from the personal computer. Houck et al disclose in a software which erases non-selected software from the personal computer. See the abstract, col 1, lines 8-14. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Christer such that it will erase unselected software. This is because it would improve Christer's system to eliminate unnecessary software from the personal computer.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mussie Tesfamariam** whose telephone number is **(703)305-1393**. The examiner can normally be reached on Monday - Friday from 8:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the **examiner's supervisor, Jim Trammell** can be reached at **(703) 305-9768**.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703)308-9051, (for formal communications intended for entry)

Or:

(703)308-5357, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to **Crystal park II, 2121 Crystal Drive**
Arlington, Virginia, (Receptionist).

Mussie Tesfamariam

May 2, 2001



**ERIC W. STAMBER
PRIMARY EXAMINER**